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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/883,025

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Gilad Lavi

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06/08/2006

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EXAMINER

AHMED, AAMER S

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/883,025		LAVI ET AL.	
	Examiner		Art Unit	
	Aamer S. Ahmed		3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03/13/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 17-27, 32-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-16 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachynsky U.S. Patent Number 5,267,963 in view of Bergman U.S. Patent Number 3,340,626.

Bachynsky ('963) discloses a needle device (10) comprising a housing (20) having a base (19) adapted to be placed next to a surface of a needle penetrating site, the base (19) including an opening (18); a needle (12) mounted for a movement between a retracted position in the housing (20) and an extended position, where a portion of the needle (12) extends through the opening (18) when in the extended position; an actuator (11) movably mounted to the housing (20) and movable between an unactuated position at which the needle (12) is in the retracted position and an unactuated position at which the needle (12) is in the extended position, the actuator being biased toward the unactuated position; a retraction mechanism (4, 5) that automatically moves

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the needle (12) from the extended position to the retracted position upon releasing the base (19) from the site surface; wherein the retraction mechanism (4, 5) maintains the needle (12) in the retracted position upon moving the actuator (11) to the actuated position; and wherein the device (10) further comprises a locking mechanism (16) that prevents the needle (12) from moving back to the extended position once the needle (12) has been moved from the extended position to the retracted position, and is integral with the retraction mechanism (4, 5) (see figures 1a, 3 and col. 3 line 45).

Bachynsky fails however to disclose that the retraction mechanism that moves the needle to the retracted position is responsive to releasing the base from the site surface and the trigger is pivotally mounted to the housing.

Bergman discloses a similar device, including a retraction mechanism that moves the needle to the retracted position is responsive to releasing the base from the site surface (see figures 1-3) and is pivotally mounted to the housing (col. 2 line 28).

It would have been obvious to one having ordinary skill in the art at the time of invention by applicant to modify the device of Bachynsky by incorporating the trigger device of the type taught by Bergman, in order to regulate the depth of penetration and shields the needle against being broken (Bergman col. 2 line 2).

6, 7 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachynsky in view of Bergman and further in view of Richard U.S. Patent 5,201,716.

Bachynsky in view of Bergman discloses the needle device as described above in references to claims 1 and 28. Furthermore Bachynsky in view of Bergman discloses that the

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device (Bachynsky 10) has a trigger member (Bachynsky 4) movably mounted to the housing (Bachynsky 20), the trigger member (Bachynsky 4) having a first portion adapted to engage the actuator (Bachynsky 11); wherein the trigger member (Bachynsky 4) is pivotally mounted to the housing (Bachynsky 20); and wherein the housing (Bachynsky 20) has an actuator guide (Bachynsky 8) that guides the actuator (11) through a predetermined path of movement, see (Bachynsky figures 1a and 3) and that the trigger member has a second portion adapted to contract the site surface (Bergman 16) .

Bachynsky in view of Bergman fails to disclose that the base includes a second opening through which the second portion of the trigger member is adapted to contact the surface nor that the retraction mechanism includes a cover member for covering the opening after the needle moves from the extended to the retracted position.

Richard ('716) discloses a similar needle device in which that the trigger member (58) has a second portion (62) adapted to contact the site surface; that the base (72) includes a second opening (see figure 2) through which the second portion of the trigger member (62) is adapted to contact the surface and that the retraction mechanism includes a cover member (70) for covering the opening after the needle moves from the extended to the retracted position, see figure 3.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to modify the needle device of Bachynsky in view of Bergman by adapting the trigger portion to contract the site surface, to add a cover member and a second base opening as taught by Richard ('716) in order to so that the assembly can be used without being touched by human hands, thereby minimizing a health worker's exposure to contaminated needles (Richard '716 col. 7. line 52).

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachynsky in view of Bergman and Richard and further in view of Wozencroft WO 93/01851. Bachynsky in view of Bergman and Richard, disclose a needle device as described above in reference to claim 7. Neither Bachynsky in view of Bergman nor Richard ('716) disclose that the guide comprises a substantially U-shaped channel formed in the housing nor that the device includes a pin adapted to be guided in the U-shaped channel.

Wozencroft ('851) discloses a similar needle device in which the guide (131) comprises a substantially U-shaped channel, (see figure 11) formed in the housing (106), the U-shaped channel comprising a first substantially vertical portion (132), a second substantially vertical guide portion (131) and a horizontal guide portion (between 131 and 132) connecting lower ends of the first and second vertical portions, see figure 11; and a pin (114) adapted to be guided in the U-shaped channel.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to modify the needle device of Bachynsky in view of Bergman and Richard by adding a substantially U-shaped channel and a pin adapted to be guided in the U-shaped channel as taught by Wozencroft ('851) in order to control of the needle in a predetermined way (Wozencroft '851 p13 line 22).

Claims 10, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachynsky in view of Bergman, Richard and Wozencroft ('851) and further in view of Miskinyar U.S. Patent Number 4,894,054.

As to claims 10 and 11, Bachynsky in view of Bergman, Richard ('716) and Wozencroft ('851) disclose a needle device as described above in reference to claim 9. Furthermore, Bachynsky ('963) discloses a spring (9) and Wozencroft ('851) discloses that the spring is fixedly mounted to the actuator (11) and is torsionally preloaded to rotate the actuator (117) from the first vertical guide portion to the second vertical portion upon moving the actuator (117) to the actuated position. Bachynsky ('963), Richard ('716), Wozencroft ('851) and Miskinyar ('054) disclose a needle device as described above in reference to claim 11.

Furthermore, Wozencroft ('851) discloses that the device includes a trigger member (118) pivotally mounted in the housing (101) and the first portion thereof adapted to engaged the pin (114) and prevent the actuator from moving to the unactuated position when the pin (114) is positioned in the second vertical guide position (131), and wherein the guide further includes a lock portion (131). Richard discloses that a portion of the trigger member and the second portion of the trigger member (62) is adapted to contact the surface and that the base (72) includes a second opening (see figure 2) through which the second portion of the trigger member (62) is adapted to contact the surface.

Neither Bachynsky in view of Bergman, Richard ('761) nor Wozencroft ('851) discloses that one end of the spring is mounted to the base to enable creation of a spring torsional load when the actuator is rotated relative to the base.

Miskinyar ('054) discloses a similar needle device with one end of the spring (102) is mounted to the base to enable creation of a spring torsional load when the actuator is rotated relative to the base, see figure 8.

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to modify the needle device of Bachynsky in view of Richard ('716) and Wozencroft ('851) by mounting the other end of the spring to the base as taught by Miskinyar ('054) in order to ensure that the medication is not prematurely ejected from the ampoule chamber (col. 5 line 19).

Response to Arguments

Applicant's arguments with respect to claims 1-11, 13-16 and 28-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aamer S. Ahmed whose telephone number is 571-272-5965. The examiner can normally be reached on Monday thru Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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